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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/164,206 09/30/98 DISTER C 98RE155

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EXAMINER

MILLER.C

ART UNIT

PAPER NUMBER

2857

DATE MAILED:
08/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/164,206

Applicant(s)

Dister

Examiner

Craig Steven Miller

Group Art Unit

2857

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 22 June 2001

☒ This action is FINAL.

- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-25

is/are pending in the application.

Of the above claim(s)

is/are withdrawn from consideration.

☐ Claim(s)

is/are allowed.

☒ Claim(s) 1-25

is/are rejected.

☐ Claim(s)

is/are objected to.

☐ Claim(s)

are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

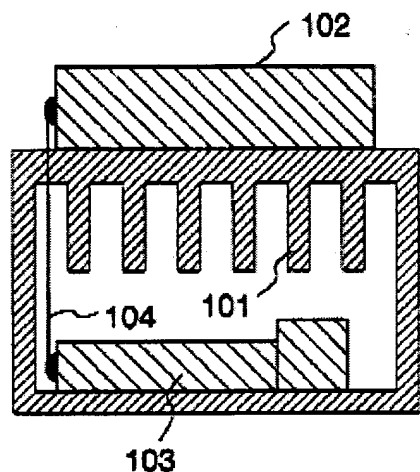
*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

1. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emori *et al.* or Root *et al.*



As to claims 1-6, 9-11, 13-18, 23 and 24, said claims are directed towards a machine with a container mounted outside the machine which receives operation data from the machine with a heat dissipation device between the container and the outside of the machine. Root *et al.* discloses a heat producing device [14], heat dissipating fins [a-d and w-z] and mounting fins [11 and 12]. To the left is an image of figure 1 from Emori *et al.* Item [102] is a high heat generating device, items [103] are electronics which should be heat insulated yet electrically connected to item [102]. Items [101] are heat dissipating fins. Neither Root *et al.* nor Emori *et al.* specify that the heat generation device is a dynamoelectric

machine, that the data concerns the operation of such a machine or that the monitoring electronics [102] are within a separate container. It is noted by the Examiner that a dynamoelectric machine generates heat which is known to be harmful to electronics. It is also well known that electronics in general and electronics for dynamoelectric machines in particular require heat insulation from high heat generating sources (see Lakin *et al.* column 1 lines 16+). It is well known to monitor machines in general and rotating machines specifically for their operating state (Applicant admits such in the middle of page 2). The Examiner notes that it is well known to make integral that which was separate, In re Larson, 144 USPQ 347 (CCPA 1965), "Although it is true that invention may be present under some circumstances in making integral that which was separate before, we do not feel that such is the case here. Improved results only will not take the case out of the general rule. There is also a requirement that the unification or integration involves more than mere mechanical skill. In re Murray, 19 CCPA (Patents) 739, 53 F.2d 541, 11 USPQ 155; In re Zabel et al., 38 CCPA (Patents) 832, 186 F.2d 735, 88 USPQ 367." Because it is known to monitor the operation of a rotating machine, because it is known that dynamoelectric machines generate heat which is harmful to electronics, it would have been obvious to one of ordinary skill in the art at the time the invention was made to integrate

monitoring electronics and the heat insulation for machine state monitoring electronics arrangement of Root *et al.* or Emori *et al.* within a dynamoelectric machine so as to receive the obvious benefits derived therefrom such as more easily performing admittedly known diagnostics to dynamoelectric machines. The Examiner notes that it is well known to make separate that which was integral, Newwin v. Erlichman, 168 USPQ 177, 179 (PTO Bd. of Int. 1969), "*The mere fact that a given structure is integral does not preclude its consisting of various elements.*" Because it is known to make separate that which is disclosed as integral, it would have been obvious to one of ordinary skill in the art at the time the invention was made to mount the monitoring electronics within an arrangement suggested by Root *et al.* or Emori *et al.* within a dynamoelectric machine but with the monitoring electronics in a separate container rather than being installed within an integral container with the heat producing device so as to receive the obvious benefits derived therefrom such as increased heat insulation and increased resistance to EMF interference from the dynamoelectric machine. The Examiner notes that because the outer connecting walls of Root *et al.* and Emori *et al.* are of the same material as the fins, they are for all intents and purposes identical to the claimed mounting heat dissipation means.

As to claim 7, said claim is directed towards the use of curved fins. Because curved fins are known generally within the art of device cooling, because neither Root *et al.* nor Emori *et al.* preclude the use of such curved fins and because the applicant fails to claim criticality to such a curved fin, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include curved fins within the devices of either Root *et al.* or Emori *et al.* as modified above as a mere obvious design choice absent a showing of unexpected results or synergistic effect by applicant.

As to claim 8, said claim is directed towards the use of fins of differing widths. Because fins of differing widths are known generally within the art of device cooling, because neither Root *et al.* nor Emori *et al.* preclude the use of such different width fins and because the applicant fails to claim criticality to such different width fins, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include different width fins

within the devices of either Root *et al.* or Emori *et al.* as modified above as a mere obvious design choice absent a showing of unexpected results or synergistic effect by applicant.

As to claim 12, said claim is directed towards the use of fins of differing materials. Because fins of differing materials are known generally within the art of device cooling, because neither Root *et al.* nor Emori *et al.* preclude the use of such different fin materials and because the applicant fails to claim criticality to such different fin materials, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include different fin materials within the devices of either Root *et al.* or Emori *et al.* as modified above as a mere obvious design choice absent a showing of unexpected results or synergistic effect by applicant.

As to claim 17, said claim is directed towards the use of fins of differing lengths. Because fins of differing lengths are known generally within the art of device cooling, because it is known generally within the cooling art that heat dissipating fins should be sized so as to prevent inadvertent contact with surfaces, because neither Root *et al.* nor Emori *et al.* preclude the use of such different fin lengths, and because the applicant fails to claim criticality to such different fin lengths, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include different fin lengths within the devices of either Root *et al.* or Emori *et al.* as modified above so as to avoid inadvertent contact with a curved surface or as a mere obvious design choice absent a showing of unexpected results or synergistic effect by applicant.

As to claims 19-22, said claims are directed towards the use of a fin cooling fan. Because fin cooling fan are known generally within the art of device cooling, because it is known generally within the cooling art that heat dissipating fins can be cooled with a fan, because neither Root *et al.* nor Emori *et al.* preclude the use of a cooling fan, and because the applicant fails to claim criticality to such a cooling fan, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a fin cooling fan within the devices of either Root *et al.* or Emori *et al.* as modified above so as to provide enhanced device cooling or as a mere obvious design choice absent a showing of unexpected results or synergistic effect by applicant.

As to newly filed claim 25, said claim is directed towards the use of a network backbone. Because Emori *et al.* as modified above discloses machine diagnostics, because it is well known within the art to use remote monitoring for such systems and because network backbones are well known for use in remote monitoring systems, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include within the device of Emori *et al.* as modified above a network backbone for remote monitoring so as to receive the obvious benefits derived there from such as providing enhanced remote monitoring.

2. Applicant's arguments filed 28 June 2001 have been fully considered but they are not persuasive.

The Examiner notes:

In re Pagliaro, 210 USPQ 888 (CCPA 1981), "*The determination that a reference is from a nonanalogous art is therefore twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.*"

In re Bozek, 163 USPQ 545 (CCPA 1969), "*The test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art.*"

In re Young, 159 USPQ 725 (CCPA 1968), "*One cannot show non-obviousness by attacking the references individually where the rejection is based on a combination of references.*"

In re Skoner, 186 USPQ 80 (CCPA 1975), "*To select features from the prior art to effect results expected from these features is within the purview of 35 USC 103.*"

In re Japikse, 86 USPQ 70 (CCPA 1950), there is no invention in shifting elements from one position to another if the operation of the device is not modified.

With respect to Applicant's arguments at the bottom of page 6, Applicant's arguments are fatally flawed, the Applicant correctly states that there exists circumstances where integration involves invention, the Applicant has failed to argue or put forth persuasive evidence that such is

the case within the claimed subject matter as was indeed argued and found in the citation put forth by Applicant. No such synergistic effect or unexpected result has been successfully argued by Applicant.

With respect to Applicant's arguments at the top of page 7, Applicant argues that the claimed subject matter is not limited to monitoring machines, while such may be the case, it is irrelevant to the rejection. Because the constructed subject matter found within the Office action falls within the limitation of the claims, it is sufficient for the rejection (Obvious for one reason, obvious for all).

With respect to Applicant's arguments at the bottom of page 7, the notes that the prior art is primarily interested with solving the problem of insulating associated electronics from a heat source. Because one of ordinary skill in the art at the time the invention was made would look towards such insulating teachings from the viewpoint of the associated electronics and not the viewpoint of the heat source, the actual source of heat is irrelevant.

With respect to Applicant's arguments at the bottom of page 7, the Examiner stated within the rejection and the Applicant failed to argue against the fact that it is known in general to monitor machines. It is not required that the prior art specify such diagnostics, it is sufficient to show that one of ordinary skill in the art at the time the invention was made would look to existing art related to the heat insulation of electronics from heat sources, that is the problem facing the inventor and identified by the prior art.

3. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

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Tech. Center 2857

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4. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Craig Steven Miller whose telephone number is (703) 305-9730. Art Unit facsimile services are now available at (703) 308-7722.

The Examiner can normally be reached on Mondays and Thursdays from 07:00am-5:30pm EDT. Should repeated attempts to reach the Examiner be unsuccessful, the Examiner's Supervisor, Marc Hoff may be reached at (703) 308-1677.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Craig Steven Miller (ss)
09 August 2001


MARC S. HOFF
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2857